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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,923	08/14/2000	Robert Bruce Spertell		8539

20995 7590 03/02/2009

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
ROBINSON, DANIEL LEON	
ART UNIT	**PAPER NUMBER**
3742	

NOTIFICATION DATE	DELIVERY MODE
03/02/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

#12

Office Action Summary	Application No.	Applicant(s)	
	09/637,923	SPERTELL, ROBERT BRUCE	
	Examiner	Art Unit	
	DANIEL L. ROBINSON	3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 28-62* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-7 and 28-62* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/ are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3-7-2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Amendment of 3-7-2008 and Petition Granted on 1-16-2009

All Claims previously indicated as allowable, are hereby withdrawn from allowable status because all claims suffer from 112 issues as indicated below.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitations

"the target feature" line 2-3, lack of antecedent basis

"greater than adjacent tissue" in line 4, vague and "adjacent tissue" line 4, vague

"permanent pathological change" line 6, vague

"without resulting in permanent pathological change" lines 7-8, vague

"the intermediate skin" line 8, lack of antecedent basis for this limitation.

Claim 4 recites "preferential heating" line 3, vague

Claim 5 recites ""about 5 mm" line 2, vague; "the intensity" line 3, lack of antecedent basis; and "radiate the target feature" line 4, lack of antecedent basis

Claim 6 recites "the target feature" lines 1-2, lack of antecedent basis; "externally visible blood vessels" line 2, external to what?? Vague; "the blood in the target vessels" lines 3-4, lack of antecedent basis; "about 55(degrees) C" vague

Claim 7 recites "the applied energy" line 2, lack of antecedent basis and "the thermal relaxation time" line 3, lack of antecedent basis

Claim 28 recites "the target vessels" line 4, lack of antecedent basis; "the selected area" line 5, lack of antecedent basis; "the confined wave energy" line 5, lack of antecedent basis; "the distributed wave energy" line 6, lack of antecedent basis; "the target skin surface area" line 8, lack of antecedent basis; "the delivery interval period" lack of antecedent basis

Claim 29 recites "the wave energy" line 3, lack of antecedent basis

Claim 31 recites "about 100 milliseconds" lines 3-4, vague and "the wave energy is in the range 14 Ghz" line 2, vague

Claim 34 recites "the characteristics" line 2, vague and "the pre-examined position" line 3, lack of antecedent basis

Claim 35 recites "the dielectric" line 2, no basis; "the characteristics" lines 2-3, no basis;

And "reflected power" line 3, reflected from what??

Claims 36 recites "The approximate relaxation time" line 2, vague and "the thermal diffusivity" line 4, no basis

Claim 37 is vague as written

Claim 42 recites "the skin surface" lines 7-8, lack of antecedent basis

Claim 49 recites "less than about 150 mm(squared)"

Claim 52 recites "the open end" line 4, there is no antecedent basis and "the dielectric portion of the body" line 5, lack of antecedent basis

Claim 58 recites "the area of the aperture" line 7, lack of antecedent basis

Claims 38-62 all have similar 112 issues and it is suggested that all claims elected be rewritten with attention to antecedent basis and vagueness.

In view of the withdrawal of allowability

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7, drawn to a method of treating a subcutaneous histological feature, classified in class 607, subclass 101.

II. Claims 28-37, drawn to a method of treating embedded blood vessels, classified in class 607, subclass 92.

III. Claims 38, drawn to a method of eliminating visible skin disorders, classified in class 607, subclass 108.

IV. Claim 39-41, drawn to a method of eliminating a subsurface telangiectasia condition, classified in class 607, subclass 101.

V. Claims 42-48, drawn to a system for applying microwave energy, classified in class 607, subclass 2.

VI. Claims 49-51, drawn to a system for treating subcutaneous histological target features, classified in class 607, subclass 2.

VII. Claims 52-57, drawn to a device for delivering microwave energy, classified in class 607, subclass 115.

VIII. Claims 58-62, drawn to an applicator for the delivery of microwave energy, classified in class 607, subclass 115.

The inventions are distinct, each from the other because of the following reasons:

Inventions Groups I-IV and Groups V-VIII are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to practice another and materially different process such as a subcutaneous (treating blood vessel or subsurface telangiectasia) or a topical procedure (visible skin disorders).

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are

subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. ROBINSON whose telephone number is (571)272-4788. The examiner can normally be reached on m-f 5:30-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu B Hoang can be reached on 571-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dlr/Daniel L Robinson/
Primary Examiner, Art Unit 3742